


TRADEMARK LAW OFFICE 15
Serial Number: 76/0778
Mark: MICROTECH & DESIGN

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**of Response to Office Action ONLY **

I certify that on November 18, 2002, which is the date I am signing this certificate, this correspondence and all identified attachments are being deposited with the United States Postal Service as U.S. Mail in an envelope addressed to: BOX RESPONSES NO FEE, Assistant Commissioner of Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.


Sharon E. Farnus

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
SOVERE S.R.L.

Serial No.: 76/077891

Filed: June 22, 2000

Mark: MICROTECH and Design

Class: 1, 17, 25

Examining Attorney:

Jordan Pulaski

Law Office: 115

BOX RESPONSES NO FEE
Assistant Commissioner of Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

REQUEST FOR RECONSIDERATION

Dear Sir/Madam:

REMARKS

This will respond to the Official Action, which issued on May 17, 2002 in connection with the above-referenced matter.

The Examining Attorney has withdrawn the refusal to register the mark based on likelihood of confusion in connection with U.S. Registration No. 2,229,972. The Examining Attorney has maintained and made final the refusal of registration based on Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), on the grounds that Applicant's mark when used on

or in connection with the identified goods, so resembles the mark in U.S. Registration No. 1,976,657 as to be likely to cause confusion, to cause mistake, or to deceive. Applicant respectfully traverses the refusal.

In assessing the similarity of the marks to determine whether a likelihood of confusion exists, the marks themselves must be considered in terms of similarities in appearance, sound, connotation and commercial impression. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Second, the Examining Attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978). Applicant contends that no confusion exists for the reasons discussed herein.

As mentioned in its previous Response, Applicant maintains that the difference in appearance when viewed in connection with the actual goods covered is sufficient to support a conclusion that the marks are not likely to be confused. This conclusion is further supported by the fact that the U.S. Patent and Trademark Office has registered several marks consisting of similar prefixes and suffixes. The co-existence of these marks indicates that the Office does consider consumers capable of distinguishing the marks and the sources of the products and services covered by each mark. Please see Attachment A which includes copies of registered marks which include MICRO and TEX or TECH.

The reason that consumer confusion was not considered likely to arise in the case of the coexisting registered marks is the same reason that confusion is not likely to arise in connection with the cited registered mark and Applicant's mark: in this case the difference in channels of trade. Registrant's goods are not sold in the same channels of trade as Applicant's goods.

In support of this contention, Applicant submits Attachment B which consists of printouts from Registrant's website showing the Registrant's actual product. Also, Applicant submits Attachment C which establishes the Uniflex, Inc., referred to in Attachment B, is in fact the same entity that owns Registration No. 1,976,657.

The website printouts indicate that Registrant's mark MICRO-TEX is used in connection with the goods identified in the registration namely, plastic sheets for use as a component in the manufacture of envelopes and bags. It further establishes that the mark is clearly used with

plastic* film or sheet integrated into the goods which are medical bags or envelopes. The mark is advertised in connection with Registrant's SPECI-GUARD bags used to transport medical specimens. The advertising indicates that the bags are made of "Slip-Free MICRO-TEX™ Film so there's less danger that the bag will slip, the container will break and the specimen will leak." Registrant's goods are designed for use in connection with the medical field as discussed above. The consumer purchasing the goods is the more sophisticated medical supply buyer or physician or lab technician with specialized experience and needs. The targeted consumer is not Joe consumer off the street.

Applicant has amended its goods to specifically identify and clarify the precise nature of the goods it sells under the mark MICROTECH and Design. The goods covered by the registered mark, and Applicant's goods are entirely different in nature and serve different purposes. Again, Applicant's class 17 goods are chemicals, resins for manufacturing molding compounds, plastics, rubber and soles for shoes. These products are sold for industrial use or for use in the manufacture of footwear. The actual consumer is sophisticated as they are purchasing the product for a highly specialized use. The consumer is not your regular person off the street. Applicant's product must travel through many processes and through other purchasers before it arrives in a form used by Joe consumer. At the point it would come close to reaching Registrant's consumer, the actual product would be sold in a different capacity under a different mark and the Registrant's consumer would unknowingly be wearing Applicant's product.

An additional factor that will militate against any likelihood of confusion between the respective marks is that the purchasers of both the Registrant's good and the Applicant's goods will give thought and careful consideration prior to purchasing the Registrant's product and the Applicant's products. The fact that purchasers exercise care in a purchase will lessen any likelihood of confusion. See Electronic Design & Sales Inc. V. Electronic Data Systems Corp., 21 U.S.P.Q.2d 1388, 1392 (Fed. Cir. 1992).

In summary, the cumulative difference between the respective marks, the Applicant's goods and the Registrants' goods, the different commercial impressions conveyed by the respective marks, the targeted consumers, and the fact that the purchasers of the respective goods are sophisticated and will exercise care in their purchases, confusion, mistake or deception of the purchasers is not likely.

Finally, the Examining Attorney cited in the first Office Action a prior pending application Serial No. 75/627,198 for MICROTECH against Applicant. This cited application which is now registered, U.S. Registration No. 2,494,744 and owned by Applicant, is in fact extremely similar to Applicant's mark. The existence of this registration for unprocessed thermoplastic materials indicates that in the real world of commerce, and on the registry the marks can and do co-exist in different commercial areas or fields without consumer confusion.

In view of the foregoing arguments and submissions, it is believed that the refusal to register based on likelihood of confusion should be reconsidered and withdrawn and the application allowed. Such action is hereby requested.

Respectfully submitted,

Dated: Nov, 18, 2002

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